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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Wolter, et al.
Appl. No. : 09/668,788
Filed : September 22, 2000
For : PROCESSIVE SUGAR
TRANSFERASE
Examiner : Rao, Manjunath N.

) Group Art Unit: 1652

) I hereby certify that this correspondence and all
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) Commissioner for Patents, Washington, D.C.
) 20231, on

January 24, 2002

(Date)

AnneMarie Kaiser, Reg. No. 37,649

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Restriction Requirement of November 28, 2001, Applicants hereby provisionally elect with traverse to prosecute the invention set forth in Group I, claims 1-6, in this application. Applicants reserve the right to prosecute Claims 13-17 in divisional applications under the provisions of 35 U.S.C. § 121.

TRAVERSAL

Applicants respectfully request that the Examiner reconsider the restriction of Group I and Groups II-IV. According to the Restriction Requirement, Groups I and II-IV are related as process of making and products made. The P.T.O. asserts that the groups encompass distinct inventions because the chemical compounds of Groups II, III and IV can be made by chemical synthesis as opposed to the use of the method of Group I.

Two or more related inventions may properly be examined together regardless of whether the inventions are distinct. *See* M.P.E.P. § 806.05. Restriction is never proper for two or more related inventions that are not distinct. *See id.* Further, restriction is not *per se* proper for two or more related inventions even if they are distinct. *See id.* Also, there must be a serious burden on the examiner if restriction is required. *See* M.P.E.P. § 803.

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Here, it is proper to examine the related claims of Group I together with the claims of Groups II-IV. Specifically, the "process" claims of Group I and the "product" claims of Groups II-IV should be examined together because the present invention makes it possible for the first time to synthesize the products as claimed in Groups II-IV. The products of groups II-IV have never been described or produced by any process in the prior art. In fact, the products were unknown until their production by the novel process of Group I. Thus, the relationship between Group I and Groups II-IV justifies and makes proper the examination of these groups together.

Examination of Groups I and II-IV together is also proper because there is no *serious* burden on the examiner if all are examined together. Here, Groups I and II-IV are classed in only two classes. According to the Restriction Requirement, Groups II-IV all have the same classification in class 536, and Group I is classed in class 436, subclass 71. It would not be a *serious* burden to examine together the inventions classed in only two classes. Further, as noted above, the products of Groups II-IV, which have never been described, are the result of the inventive effort of the process of Group I, which permitted the making of the products for the first time. Finally, the process and products are so related that the fields of search most likely will overlap so that there is little or no difference in the field of search. Therefore, restriction is improper because there is no *serious* burden placed upon the examiner as mandated by the M.P.E.P. § 803 and § 808.02. Based upon the foregoing, Applicants respectfully request reconsideration of the Restriction Requirement.

Should the Examiner have any questions in connection with this submission or the application in general, he is invited to contact the undersigned attorney.

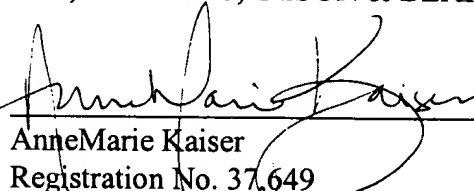
Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

Jan. 24, 2002

By:


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